

Attorney Docket No. 05725.0783
Application No.: 09/820,812

REMARKS

I. Status of Claims

Claims 1-100 are pending in this application. Claims 7-16, 18, 20, 21, 34-42, 55-64, 66-69, and 82-90 have been withdrawn by the Examiner. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, and 91-100 have been examined.

II. Double Patenting Rejection

Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, and 91-100 have been rejected under nonstatutory obviousness-type double patenting as being unpatentable over claims 44-146 of U.S. Patent No. 6,486,105. *Office Action* at pp. 2-3. Applicants respectfully traverse this rejection, but, at this time, respectfully request that this rejection be held in abeyance until allowable subject matter is indicated. At that time, Applicants will consider whether or not to file a Terminal Disclaimer.

III. Rejection under 35 U.S.C. § 103

Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, and 91-100 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,004,545 ("Karlen") in view of U.S. Patent 5,688,930 ("Bertho '930") or U.S. Patent No. 6,087,403 ("Bertho '403"). *Office Action* at pp. 3-4. Applicants respectfully traverse this rejection.

The Examiner states that Karlen teaches compositions including amphoteric polymers such as AMPHOMER LV-71. *Office Action* at p. 3. Moreover, the Examiner alleges that Karlen's compositions "necessarily include a surfactant chosen from a group that includes nonionic surfactants" and notes that "nonionic surfactants such as

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alkylpolyglucosides are particularly preferred." *Id.* at pp. 3-4. Because Karlen does not teach a mixture of hexadecyl and octadecyl glycosides, the Examiner relies on Bertho for teaching "mixtures of alkyl glycosides ... useful as surfactants." *Id.* at p. 4.

Applicants respectfully disagree. Applicants submit that Karlen does not teach the specific combination of Amphomer LV-71 and alkylpolyglucoside, as alleged by the Examiner. Instead, the Examiner has used improper hindsight to reconstruct the Applicants' claims.

Karlen teaches a hair cleansing composition, *i.e.*, a shampoo, comprising: (a) at least one nonionic, water-insoluble vinyl/silicone copolymer having a backbone chain of siloxane polymer units and a side chain of vinyl polymer units, and (b) at least one detergent surfactant selected from the group consisting of nonionic, anionic, cationic and amphoteric surfactant compounds. *Karlen* at col. 2, lines 13-20. From this teaching, the Examiner focuses solely on alkylpolyglucosides.

Karlen further teaches that anionic, cationic, amphoteric, or nonionic film-forming polymers can be added. *Id.* at col. 7, lines 4-6. Again, Karlen provides a large selection of these ingredients from col. 7, line 16 to col. 8, line 15. The Examiner, however, chooses to focus only on the disclosure of Amphomer LV-71 at col. 8, line 7 from this laundry list of merely possible ingredients.

The Federal Circuit has cautioned against this particular type of hindsight reconstruction in *Kotzab*. 217 F.3d 1365 (Fed. Cir. 2000). The Federal Circuit recognized that "[m]ost, if not all inventions arise from a combination of old elements ... every element of a claimed invention may often be found in the prior art." *Id.* at 1369-1370. The *Kotzab* invention was directed to a process of controlling the temperature of

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an injection mold by using a single sensor. *Id.* at 1367. The PTO's rejection relied on two statements in a single prior art reference. *Id.* at 1371. The court found that the PTO impermissibly viewed these two statements "in the abstract," as opposed to being considered in the context of the entire reference. *Id.* at 1371. In cautioning against hindsight reconstruction, the court stated:

[A] rejection cannot be predicated on the mere identification in Evans of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

Id. (emphasis added).

Applicants respectfully submit that a similar hindsight analysis has occurred here. Just as in *Kotzab*, the Examiner has identified individual components in the specification, namely Amphomer LV-71 and alkylpolyglucoside, by using the Applicants' claims as the template. The *Kotzab* ruling makes clear that the Examiner's rejection must be founded "with no knowledge of the claimed invention." Karlen does not teach this specific combination and none of the Examples in Karlen list this particular combination. Applicants can only conclude that improper hindsight was used to fashion this rejection.

Applicants also respectfully submit that the combination of Karlen and Bertho '930 is improper. The references, whether alone or in combination, fail to provide specific guidance that a particular surfactant from the large number of possibilities, *i.e.*, the alkyl glucoside of Bertho '930, would particularly benefit Karlen's compositions.

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Because the references do not show such specific teachings or suggestions, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

IV. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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